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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,165	05/08/2001	Peter Lind	00231regUS/PHRM-0442	3975

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 09/03/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,165

Applicant(s)

LIND ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Election/Restriction

- A. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-22, 25-29 and 67-72, drawn to an isolated polynucleotide of SEQ ID NO:1, or encoding SEQ ID NO:2, allelic variants thereof, as well as expression vectors, compositions comprising these polynucleotides and vectors, host cells, and a process for producing a polypeptide, classified in class 435, subclass 69.1.
 - II. Claims 23 and 24, drawn to antisense oligonucleotides of SEQ ID NO:1, classified in class 536, subclass 23.5.
 - III. Claims 30-35, drawn to an isolated polypeptide of SEQ ID NO:2, allelic variants and compositions thereof, classified in class 530, subclass 350.
 - IV. Claims 36-38, drawn to an antibody to SEQ ID NO:2, classified in class 530, subclass 387.1.
 - V. Claim 39, drawn to a method of inducing an immune response by administering the polypeptide of SEQ ID NO:2, classified in class 435, subclass 7.2.
 - VI. Claims 40-43, drawn to a method of identifying a compound which binds nGPCR-2067, classified in class 435, subclass 7.1.
 - VII. Claim 44, drawn to a compound which binds nGPCR-2067 protein, class and subclass undeterminable.
 - VIII. Claims 45 and 46, drawn to a method of identifying a compound which binds a nucleic acid molecule encoding nGPCR-2067, classified in class 435, subclass 6.
 - IX. Claim 47, drawn to a compound which binds nGPCR-2067 nucleic acid, class and subclass undeterminable.
 - X. Claims 48-51 and 74, drawn to a method of identifying a compound which modulates nGPCR-2067, classified in class 435, subclass 7.1.
 - XI. Claim 52, drawn to a compound which modulates nGPCR-2067 protein, class and subclass undeterminable.
 - XII. Claims 53-55, drawn to a method of identifying animal homologs of nGPCR-2067 using nucleic acid, classified in class 435, subclass 6.
 - XIII. Claims 56-66, drawn to a method of screening a human to diagnose a disorder involving nGPCR-2067, or an allelic variant, and a kit, classified in class 435, subclass 6.

Art Unit: 1647

- XIV. Claim 73, drawn to a method of identifying a modulator of a biological activity nGPCR-2067, classified in class 435, subclass 7.1.
- XV. Claims 75-77, drawn to a method of identifying a modulator of nGPCR-2067 and a nGPCR-2067-binding protein, classified in class 435, subclass 7.1.
- XVI. Claims 78 and 79, drawn to a method of purifying a G protein from a sample, classified in class 435, subclass 7.1.

B. The inventions are distinct, each from each other because of the following reasons:

Inventions I, II, III, IV, VII, IX and XI are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. The polypeptide of Invention III can be used for purposes other than to make an antibody of Invention IV, such as for therapeutic, or diagnostic purposes (e.g. in screening). The polynucleotide of Invention I can be used to make a hybridization probe, or can be used in gene therapy as well as to produce the polypeptide of interest. The antibody of Invention IV can be used for reasons other than to obtain the protein of Invention III, such as in diagnostics (e.g. as a probe in immunoassays, or in immunochromatography), or therapeutically.

Inventions I and VIII, XII, XIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h). In the instant case the polynucleotide can be used to make the protein of interest.

Invention I is unrelated to V, VI, X, XIV-XVI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention II is unrelated to V, VI, VIII, X, XII-XVI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Art Unit: 1647

Invention III and V, VI, X, XVI-XVI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h). In the instant case the polypeptide can be used to make an antibody.

Invention III is unrelated to VIII, XII, XIII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention IV is unrelated to V, VI, VIII, X, XII-XVI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention V, VI, VIII, X, XII-XVI are independent and distinct because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Inventions V, VI are unrelated to VII, IX, XI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention VII is unrelated to VIII, X, XII-XVI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention VIII are unrelated to IX, XI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention IX is unrelated to X, XI-XVI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Art Unit: 1647

Invention X is unrelated to XI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention XI is unrelated to XII-XVI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

C. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

Art Unit: 1647

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
September 03, 2002

A handwritten signature in black ink, appearing to read 'R. Landsman', is located to the right of the typed name and date.